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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/008,229	11/30/2001	Yakov Kamen	ISURFTV152	6955
52940	7590	01/30/2006		
TODD S. PARKHURST HOLLAND & KNIGHT LLP 131 S. DEARBORN STREET 30TH FLOOR CHICAGO, IL 60603			EXAMINER JOHNSON, ALAN M	
			ART UNIT	PAPER NUMBER
			2611	

DATE MAILED: 01/30/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

10/008,229

Applicant(s)

KAMEN ET AL.

Examiner

Alan M. Johnson

Art Unit

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-18 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-18 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)                        | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)               | Paper No(s)/Mail Date. ____   |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>1/31/2002</u> .   | 6) <input type="checkbox"/> Other: ____                                     |

## **DETAILED ACTION**

### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 4, 5, 7, 10, 11, 13, 16, 17 are rejected under 35 U.S.C. 102(e) as being anticipated by McClard (6,438,752).

As for claims 1, 7, 13, McClard discloses a system and corresponding method, and machine-readable medium comprising:

- a) a first unit (36 Fig. 2 or 54 Fig. 3) to provide a first set of categories of content of broadcasted programs (column 4 lines 35-39 and 54-61);
- b) and a second unit (56 Fig. 3) coupled with the first unit (54 Fig. 3) to add a category from the first set to a second set of categories of broadcasted programs in response to selecting the category from the first set (when a program is watched by the user for a period of time greater than a previously set time, the category of that channel is automatically stored into memory Fig. 5 and column 5 lines 54-61 and column 5 lines 33-42).

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With respect to claims 4, 10, 16, McClard discloses an EPG system wherein the second unit (56 Fig. 3) is also to tune a broadcasted program viewing device (40 Fig. 3) to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time (column 5 lines 29-42 and column 6 line 62 – column 7 line 21).

Dealing claims 5, 11, 17, McClard discloses an EPG system wherein the second unit (56 Fig. 3) is also to tune a broadcasted program viewing device (40 Fig. 3), upon a singular pressing of a button (76 Fig 4), to a channel on which a broadcasted program predetermined to be in a category from the second set will be broadcasted within a predetermined threshold of a current time (column 5 lines 29 – 42 and column 6 line 62 – column 7 line 21).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 6, 8, 12, 14 and 18 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard in view of Ohkura (6,128,009).

In regards to claims 2, 8, and 14, McClard fails to specifically teach a second unit that is also to remove a category from the second set upon a selecting of the category from the second set.

In an analogous art, Ohkura discloses an EPG system wherein the second unit (24H Fig. 4) removes a category from a second set upon a selecting of the category from the second set (column 28 lines 41-60).

It would have been obvious to one of ordinary skill in the art to modify McClard's system to include the second unit to remove a category from the second set upon a selecting of the category from the second set, as taught by Ohkura, for the benefit of allowing the user to manually remove an undesirable category.

In regards to claims 6, 12, and 18, McClard fails to specifically teach a second unit that verifies an adding of a category from the first set to the second set.

In an analogous art, Ohkura discloses an EPG system wherein the second unit (24H Fig. 4) verifies an adding of the category from the first set (24A Fig. 4) to the second set (The CPU verifies that the new genre registrations have been reasonably completed Oh column 32 lines 19-25).

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It would have been obvious to one of ordinary skill in the art to modify McClard's system to include the second unit to verify an adding of the category from the first set to the second set, as taught by Ohkura, for the benefit of allowing a user to make sure that the category that was added is the category that the user intended to add.

5. Claims 3, 9, and 15 are rejected under 35 U.S.C. 103(a) as being unpatentable over McClard in view of Mori (US2004/0210932).

Dealing with claims 3, 9, and 15 McClard fails to specifically teach a second unit that is also to remove a category from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set.

In an analogous art, Mori discloses an EPG system wherein the second set (104 Fig 40 and favorite genre Fig 41.) upon a broadcasted program viewing device (107 Fig 40) not being tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set (The retention period is equal to the second predetermined threshold, in Mori's system once the device has reached the retention period which is the same as not being tuned for a predetermined threshold, the program with the favorite genre will be deleted from memory paragraph 328 lines 12-14).

It would have been obvious to one of ordinary skill in the art to modify McClard's system to include a second unit that is also to remove a category from the second set upon a broadcasted program viewing device not being tuned, for a period of time at least equal to a second predetermined threshold, to at least one broadcasted program predetermined to be in the category from the second set, as taught by Mori, for the advantage of automatically removing categories that were added by one time user who tuned to a program that the regular user would not normally view.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alan M. Johnson whose telephone number is (571)272-7916. The examiner can normally be reached on 8am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Christopher C. Grant can be reached on (571)272-7294. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

AJ



**CHRISTOPHER GRANT**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2800**